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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,919	12/04/2003	Marvin M. Johnson	2253-01201	7550

23505 7590 09/19/2007
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EXAMINER

NGUYEN, CAM N

ART UNIT	PAPER NUMBER
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1754

MAIL DATE	DELIVERY MODE
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09/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/727,919

Applicant(s)

JOHNSON ET AL.

Examiner

Cam N. Nguyen

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/09/07 (an amendment/response).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-119 is/are pending in the application.
- 4a) Of the above claim(s) 78-111 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-77, & 112-119 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicants' amendments and remarks, filed on July 09, 2007, have been made of record and entered. Claim 17 has been canceled. Claims 14, 37, 51, 66, & 112 have been amended.

Claims 1-16 & 18-119 are currently pending in this application.

Status of Withdrawn Claim(s)

2. Claims 78-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Election was made without traverse in the reply filed on June 27, 2006.

Claim Rejections - 35 USC § 102(a)

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-7, 12-16, 18-20, 22-30, 32-33, 36-44, & 50-70 are rejected under 35 U.S.C. 102(a) as being anticipated by Ryu et al., "hereinafter Ryu '588", (US Pat. 6,576,588 B2).

Ryu '588 discloses a catalyst for selective hydrogenation of acetylenes which comprising a copper component and a member selected from the group consisting of at least one Group VIII metal component, a Ag component, a Au component and mixtures thereon on an alumina support, etc. (see col. 17, claim 1). The Group VIII metal component is Pd (see col. 18, claim

6). The catalyst further comprising a Zn component (see col. 18, claim 7). The claimed Group VIII metal and second metal concentrations appear met by the teachings of the reference (see col. 8, lines 12-35 and Examples in the reference).

Recitation on “wherein the catalyst is capable of selectively hydrogenating acetylene with a conversion Sc of at least about 95% and a selectivity to ethylene relative to ethane Sc of at least about 25 when the catalyst is employed in a steady-state liquid phase hydrogenation process” in the instant claim 1 and other intended use limitations set forth in the dependent claims are noted. It is considered the catalyst disclosed by Ryu would inherently perform or capable of performing the same because both the disclosed catalyst and the claimed catalyst contain the same metal components and having the same composition.

5. Claims 8-11, 21, 31, 34-35, 45-49, & 71-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryu et al., “hereinafter Ryu ‘588”, (US Pat. 6,576,588 B2), as applied to claims 1-7, 12-16, 18-20, 22-30, 32-33, 36-44, & 50-70 above, and further in view of Brown et al., “hereinafter Brown ‘805”, (PG. Pub. No. US 2001/0001805 A1).

Ryu ‘588 discloses a catalyst as described above, except for the claimed Group Group VIIB metals (or Mn).

However, it would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have incorporated by adding these metal components into the catalyst of Ryu in order to achieve an improved catalyst having improved in the performance and activities because they are known as useful catalyst materials as evidenced by Brown ‘805 (see Brown ‘805 at page 9, claims 7 & 19).

6. Claims 112-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryu et al., "hereinafter Ryu '588", (US Pat. 6,576,588 B2).

Ryu '588 discloses a catalyst as described above.

Product-by-process in the claims are noted. While the catalyst of the reference is not made by the same process, the catalyst disclosed is the same as being claimed. It has been held that the patentability of the product and its method of production are separately determined. Thus, even though the process limitations in the claims are not disregarded, they have no bearing on the patentability of the claims product per se. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also *MPEP 2113*.

Response to Applicants' Arguments

7. Applicants' response filed on July 09, 2007 has been fully considered, but not deemed persuasive in view of the new ground of rejection(s) and/or objection(s) above and the following reasons.

The transitional phrase "consisting essentially of" in the independent claims are noted. It is considered Ryu '588 anticipates the instant claims because he teaches a catalyst, which does not contain a halogen component or metal components other than those being required in the instant claims.

Citations

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form attached.

Conclusion

9. Claims 1-16 & 18-119 are pending. Claims 1-16, 18-77, & 112-119 are rejected. Claims 78-111 remain withdrawn due to non-elected (distinct) invention(s). No claims are allowed.

Contacts

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Nguyen/cnn

Primary Examiner

September 14, 2007

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